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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,541	11/29/2001	Derek Forbes	ACO6194US	7266

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EXAMINER

TSOY, ELENA

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,541

Applicant(s)

FORBES ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Response to Amendment

1. Amendment filed on February 22, 2005 has been entered. New claim 11 has been added. Claims 2-11 are pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 9, 2, 3, 10** are rejected under 35 U.S.C. 102(b) as being anticipated by Larson et al (US 5,425,968) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on August 16, 2004.
4. **Claim 11** is rejected under 35 U.S.C. 102(b) as being anticipated by Larson et al (US 5,425,968).

Larson et al disclose a process for making and applying a coating composition using a plural component apparatus (See column 2, lines 49-50) employing in some cases *more than two* packages or components (See column 1, lines 59-61; column 5, lines 40-48) such as a combination of functional groups: *hydroxy/isocyanate/amine, amine/epoxy/isocyanate* (See column 9, lines 50-60) comprising selecting a mixing ratio for the components (See column 4, lines 61-63), mixing the components of the coating composition and applying by spraying the coating composition (See column 1, lines 15-18; column 3, lines 1-2); whereby a **plurality of coating compositions** with varying properties can be made and applied to the substrates (See column 9, lines 31-35, 49-65). Larson et al further teach that the method may be used to apply coating compositions such as

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primers, basecoats, topcoats, or clearcoats, especially convenient for applying clearcoats and primers, since they are normally one color and therefore do not require color changes between applications, and it is therefore not necessary to use solvents to purge the equipment between use (See column 9, lines 3-13).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson et al (US 5,425,968) in view of Vu (US 4,710,560) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on August 16, 2004.

Response to Arguments

7. Applicants' arguments filed February 22, 2005 have been fully considered but they are not persuasive.

(A) Applicants argue that Larson only discusses and claims two package systems. The office action cites column 1, lines 59-61 and column 5, lines 40-48 as demonstrating that the Larson apparatus may employ more than two packages or components. It is respectfully noted that column 1, lines 59-61, is a general discussion of the background of the art in which it is merely

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stated that in refinish applications, the coating material may be the product of two packages/components or in some cases, more than two packages or components. This discussion is not specific to the Larson apparatus and clearly does not teach, suggest or disclose that the Larson apparatus may be utilized in those cases where the coating material is the product of more than two packages or components. With regard to column 5, lines 40-48, there is merely a general blanket statement that a skilled artisan may analogously modify the apparatus for a three or more package system. There is no teaching or example on how the apparatus may be so modified.

The Examiner respectfully disagrees with this argument. Larson teaches that his method allows the formulator greater latitude in modifying existing chemistries without being limited to the pot life requirements of existing methods in automotive refinish (See column 9, lines 13-26). Therefore, existing chemistries at column 1, lines 59-61 are relevant to Larson's teaching. Moreover, Larson does teach examples how the apparatus may be so modified

(B) Applicants argue that reference of Larson fails to disclose ability to spray different coating compositions on variety of substrates having various requirements using the same fixed components and doing so by simply changing the mixing ratios of the fixed component. Moreover nothing in Larson even suggests the idea that its components would remain fixed where the needs of the substrate would be different.

As was discussed above, Larson et al teach that a system comprising fixed multiple components (See column 5, lines 45-48) can be used for refinishing automobiles and *other* substrates by supplying the components of a coating composition in a *proper* mix ratio (i.e. depending on particular application) (See column 4, lines 24-27), either involving modified or new chemistry, having various VOC levels or **concentrated catalysts** in response to **various dry time**

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and **cure time needs**, for example for **spot repair versus overall repair** (See column 9, lines 14-26, 40-49).

(C) Applicants argue that although it is true that the Larson apparatus may be used to apply different coating compositions, such as primers, basecoats, topcoats, clearcoats, etc, nowhere in Larson is it taught, suggested, or disclosed that such different coating compositions may be formulated and applied without changing the original combination of components utilized or without disassembling the apparatus. For example, in order to vary the ratios of the components being used, and thereby form a different coating composition, it is necessary to stop use of the Larson apparatus and replace one or more of the cylinders or piston rods with cylinders or piston rods of different diameters (see col. 7, lines 36 –52 and col. 8, lines 44-46). As the cylinders or piston rods would need to be replaced in order to change the ratio of the components, it is not possible to change the ratio of the components, and hence the coating formulation, while the components remain fixed in the apparatus, as is taught and claimed in the present application. As such, Larson does not teach, suggest or disclose a specific combination of components which may be utilized to provide different coatings merely by changing the ratios of the same specific combination of components during the same use of a plural component apparatus, while the same combination of components remain fixed within the plural component apparatus.

As to disassembling the apparatus and the cylinders or piston rods being replaced,, Larson et al teach that the method may be used to apply coating compositions such as primers, basecoats, topcoats, or clearcoats, especially convenient for applying clearcoats and primers, since they are normally one color and therefore do not require color changes between applications, and it is therefore not necessary to use solvents to purge the equipment **between** use (See column 9, lines 3-13). Larson et al further teach that a *separate* cylinder and piston may be used for each

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component composition, although **various configurations of pistons and cylinders and their cooperation** are available to the **skilled artisan** for use in such a proportioning device including embodiments where the movement of the separate pistons are simultaneous, by physical connection or other means, and the stroke length of each is the same. By this means, if only one component is supplied under pressure, it can provide the energy to "pump" the other components through the proportioning device (See column 3, lines 45-59).

In other words, Larson et al teach that the same apparatus can be used for applying next coating **without disassembling** the apparatus using **various configurations of pistons and cylinders and their cooperation** available to the **skilled artisan** for use in such a proportioning device.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-141523. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELENA TSOY
PRIMARY EXAMINER
E Tsoy

Elena Tsoy
Primary Examiner
Art Unit 1762

April 4, 2005